II. Remarks

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1, 25-30, 32-42 and 44-47 are pending in the application. Claims 1 and 36 are independent. Claims 31 and 43 have been canceled. Claims 2-24 were canceled in a previous amendment.

The Office Action dated February 22, 2008 ("Office Action") rejected Claims 1, 25-29, 31-32, 35-41, 43-44 and 47 under 35 U.S.C. 103(a) as being unpatentable over Kalavade et al. (US 200310051041) in view of Takeuchi (US 2003/0134615) in further view of Harnesk et al. (US 20060008063).

The Office Action rejected Claims 30 and 42 under 35 U.S.C. 103(a) as being unpatentable over the grounds of rejection as applied to claims 1 and 36 above, and further in view of Schlieben et al. (US 200310096605).

The Office Action rejected Claims 33-34 and 45-46 under 35 U.S.C. 103(a) as being unpatentable over the grounds of rejection as applied to claims 31 and 43 above and in further view of Brown et al. (US 2003101 12936).

For at least the reasons articulated below, Applicants respectfully traverse all rejections.

As a preliminary matter, having reviewed the rejections[1] raised in the Office Action, Applicants voluntarily amended independent claims 1 and 36 to specify "***sending an instruction from said access gateway to said rating element ...***", with the hopes that it will provide further clarity. Amended claim 1 is reproduced for convenience below:

[1] and without agreeing with those rejections.

1. (Currently Amended) In a wireless local area network (WLAN) gateway system comprising:
an access gateway connected to a server;
a session controller connected to said access gateway;
a charging element connected to said session controller; said charging element maintaining charging details associated with a mobile handset;
a rating element connected to said session controller; said rating element maintaining rating profile information associated with said mobile handset
an interface connected to said access gateway for connecting said mobile handset to said access gateway via said interface;
a computing device connected to said access gateway via a WLAN access network;
a method for providing access to said server from said computing device comprising:
receiving at said access gateway authentication information for a subscriber associated with said computing device;
sending a first message from said access gateway to said mobile handset; and,
if no reply to said first message is received within a configurable interval from said subscriber then denying said computing device access said server; and
if a reply to said first message is received, then permitting said computing device to access said server and, during said access;
sending an instruction from said access gateway to said rating element to determine a rate for packets carried between said computing device and said WLAN access network to establish a rate of charge for each of said packets according to a different classification assigned to each of said packets; and
sending an instruction from said access gateway to said charging element representing charging details associated with the access of said server by said computing device; said charging details based on said rate.

At the outset, Applicants note that the Office Action concedes that at least the following element is not satisfied by Kalavade[2]:

> ***sending an instruction [from said access gateway] to said rating element to determine a rate for packets carried between said***

[2] Applicants do not concede that the other elements of claim 1 are satisfied by Kalavade.

computing device and said WLAN access network to establish a rate of charge for each of said packets according to a different classification assigned to each of said packets; and

Indeed, as previously submitted by the Applicants, Kalvade does not disclose or suggest a rating element or a rating function. As previously submitted by the Applicants, at Paragraph 13, Kalavade teaches that the CBG receives and forwards (transmits) charging information to a downstream (post-paid) billing system. At Paragraph 232, Kalavade emphasizes that the *"actual rating is done by the operator's existing systems."*

Applicants note that the Office Action relies on Harnesk as satisfying the limitation "***sending an instruction to said rating element ...***" in Claim 1. However, Applicants further note that the text in Harnesk as cited in the Office Action is obtained from a PCT specification filed June 27, 2003 whereas the present specification was filed June 19, 2003. Applicants therefore submit that the rejections in the Office Action based on Harnesk are improper. For purposes of preparing this response, Applicants have therefore disregarded the rejections based on Harnesk itself, as such objections are moot. Applicants note that Harnesk does claim priority from US Provisional Application 60/418,547 ("Harnesk Provisional"; copy attached) filed October 15, 2002, but the text of the Harnesk Provisional is different from Harnesk itself.

In order to further prosecution and assist the USPTO in its obligations to protect the public interest, Applicants reviewed the Harnesk Provisional and prepared this response accordingly. [3]

[3] Applicants note that any further dialogue from the USPTO on this subject must reference text found in the Harnesk Provisional and not Harnesk.

Section 103 Analysis

The Office Action was issued following the United States Supreme Court's decision in the case of KSR Int'l Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007). In light of the KSR decision, Applicants wish to address various issues pertaining to a proper analysis under section 103.

Applicants note the following legal principles have been endorsed by the Supreme Court: (1) the USPTO has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicants are entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

The Office Action, by citing references and asserting a reason for combining elements from the references, has elected to base rejection upon a teaching, suggestion or motivation to select and combine features from the cited references, an approach that is characterized by the Supreme Court as "a helpful insight." See KSR slip op. at 14-15. [4]

[4] The Supreme Court noted that a "teaching, suggestion or motivation" analysis was not the only possible analysis of an obviousness question. Because of the USPTO's chosen ground for rejection, however, the only pending ground for rejection must be a "teaching, suggestion or motivation" analysis. In the event that the USPTO chooses to consider a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicants have a right to be heard on any new ground for rejection.

When the Office Action includes a rejection based upon a teaching, suggestion or motivation analysis, the Office Action must satisfy the requirements of such an analysis. Of note, the Office Action must demonstrate with evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility. In re Fulton, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

As previously noted, Kalavade does not teach rating within the CBG and in fact Kalavade, at Paragraph 232 states that the CBG itself preferably does NOT generate any billing information and that the CBG merely collects usage information and couples to the operator's billing entities that use this usage information to generate the final bill. Quoting Kalavade:

> [0232] The CBG itself preferably does not generate any billing information. The CBG collects usage information and couples to the operator's existing billing entities that use this usage information to generate the final bill. ***The actual rating is done by the operator's existing systems.***

Thus, in a proper Section 103 analysis, one must consider the fact that Kalavade ***teaches away from at least the feature of "sending an instruction from said access gateway to said rating element".*** It must therefore be noted then that Kalavade **cannot** be properly combined with the Harnesk Provisional, or other prior art, as ***Kalavade expressly teaches away from the rating feature as currently claimed***. Applicants note that the Office Action does not address the Applicants' previously-submitted argument with respect to this point. The Office Action contains no rational underpinning or articulated reasoning that addresses paragraph 232

of Kalavade, and therefore for this reason alone, withdrawal of the Section 103 objection is warranted.

Notwithstanding the fact that the Office Action does not address paragraph 232 of Kalavade, Applicants note that the Office Action relies on Paragraph 14 of Harnesk as the motivation "... to utilize the teachings of Harnesk with the teachings in the combination of Takeuchi and Kalavade", on the grounds that the person skilled in the art would have been motivated to " ... allow for providing a flexible real-time charging system, whereby signaling between systems is reduced (Harnesk par. 14)."

It is important to actually review the contents of paragraph 14:

> [0014] Therefore, a first object of the present invention is to achieve arrangements for providing a [sic] flexible realtime charging, ***whereby the signaling between the control system and the packet forwarding system is reduced***.

Thus, note that the Office Action employs improper hindsight reconstruction by inaccurately reproducing the text of Harnesk. The Office Action refers to "signaling between systems" being reduced, but Harnesk specifically refers to a control system and a packet forwarding system. In any event, Applicants again note that paragraph 14 of Harnesk is not even properly citable due to its filing date. Similar text (though not identical text) is found on Page 5, of the Harnesk Provisional:

> According to embodiments of the present invention, a reduced amount of signaling traffic can be realized between ***the control system and the packet forwarding system***.

Thus, In order to provide the ***requisite rational underpinning prescribed by KSR*, even under the Harnesk Provisional,** it is incumbent on the USPTO to demonstrate that combining the rating feature of the Harnesk Provisional with Kalavade is motivated because of a desire to provide a ***reduced amount of signaling traffic between a control system and a packet forwarding system***. The USPTO has not demonstrated what aspects of the Harnesk Provisional, Kalavade and the presently pending claims constitute the "control system" and which aspects constitute the "packet forwarding system" as cited in Harnesk Provisional. The requisite rational underpinning and articulated reasoning cannot be provided without such a discussion. It is the USPTO's burden to demonstrate such a motivation, providing a rational underpinning and articulated reasoning, and the USPTO has not discharged this burden.

In fact, the proposed combination of Kalavade with the Harnesk Provisional would result in an increase of the signaling traffic, as there would be more signaling required in order to fulfill the "rating" function which does not actually occur within Kalavade, and is expressly discouraged by Kalavade. Thus, the cited passage of Harnesk also serves to ***teach away from a combination of the Harnesk Provisional with Kalavade.***

Coming full circle, it is still incumbent on the USPTO to address the fact that Kalavade, at paragraph [0232], teaches away from the rating element as currently claimed.

Other arguments and the dependent claims

As the claims not expressly discussed above, (and/or which have already been expressly discussed in previous responses), all now depend from independent claims which are now deemed allowable, Applicants respectfully submit that those dependent claims are also now allowable.

In view of the above remarks, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3500. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

/Richard P./ Bauer/
Attorney for Applicants
Richard P. Bauer
Registration No. 31,588

KATTEN MUCHIN ROSENMAN, L.L.P.
1025 Thomas Jefferson Street, N.W.
East Lobby, Suite 700
Washington, D.C. 20007-2501
Facsimile: (202) 298-7570
Customer No.: 27160